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MAR 23 2009

In re Application of	:	OFFICE OF PETITIONS
Victor R. Sanchez, Alberto	:	
Ceja, and Rigoberto Anguiano	:	
Application No. 09/753,171	:	DECISION ON PETITION
Filed: December 29, 2000	:	PURSUANT TO
Attorney Docket No. CAS1PAU24R2	:	37 C.F.R. § 1.47(A)
Title: METHODS FOR HANDLING	:	
MASA	:	

This is in response to the petition pursuant to 37 C.F.R. § 1.47(a), filed July 9, 2008.

This petition is **DISMISSED**.

The present application is for the reissue of U.S. Patent number 5,635,235, which issued on June 3, 1997, from application number 08/476,198.

On December 29, 2000, the present reissue application was filed, identifying Victor R. Sanchez, Alberto Ceja, and Rigoberto Anguiano as joint inventors. On January 14, 2008, a final Office action was mailed, which indicated "the reissue oath/declaration filed with this application is defective..."¹

This petition pursuant to 37 C.F.R. § 1.47(a) was submitted in response to this indication, along with, *inter alia*, a three-month extension of time so as to make timely this response, the petition fee, the surcharge associated with the late submission of an oath or declaration, the last known address of each non-signing joint inventor, a statement that a complete copy of the

¹ Final Office action of January 14, 2008, paragraph 3.

application was sent to each non-signing joint inventor, and a reissue declaration that has been executed by Mr. Anguiano.

A grantable petition pursuant to 37 C.F.R. § 1.47(a) requires:

- (1) the petition fee of \$200;
- (2) a surcharge of either \$65 or \$130 if the petition is not filed at the time of filing the application, as set forth in 37 C.F.R. § 1.16(f);
- (3) a statement of the last known address of the non-signing inventors;
- (4) either
 - a) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review and proof that the non-signing inventor refuses to join in the application or
 - b) proof that the non-signing inventor cannot be found or reached after diligent effort, and;
- (5) a declaration which complies with 37 C.F.R. § 1.63.

Petitioner has met requirements (1) - (3) of 37 C.F.R. § 1.47(a). Petitioner has not met requirements (4) and (5), as will now be pointed out.

Regarding the fourth requirement of 37 C.F.R. § 1.47(a), Petitioner has asserted that a complete copy of the reissue application was sent to both of the non-signing inventors, however the petition does not indicate the result. Were these mailings met with silence from the two non-signing joint inventors? Did each reply and indicate that he would not execute the reissue declaration that had been sent to him? Was notice received from the postal service, indicating that delivery was either achieved or not successful for these mailings?

On renewed petition, Petitioner will need to explain what happened subsequent to these mailings.

Regarding the fifth requirement of 37 C.F.R. § 1.47(a), the reissue declaration that was submitted with this petition cannot be accepted, as Rule 1.172 has not been complied with.

37 C.F.R. § 1.172 sets forth, in pertinent part:

(a) A reissue oath must be signed and sworn to or declaration made by the inventor or inventors except as otherwise provided (see §§ 1.42, 1.43, 1.47), and must be accompanied by the written consent of all assignees, if any, owning an undivided interest in the patent, but a reissue oath may be made and sworn to or declaration made by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent. All assignees consenting to the reissue must establish their ownership interest in the patent by filing in the reissue application a submission in accordance with the provisions of § 3.73(b) of this chapter.

MPEP § 1412.04(II) sets forth, in pertinent part:

Where a reissue to correct inventorship also changes the claims to enlarge the scope of the patent claims, the signature of all the inventors is needed. However, if an inventor refuses to sign the reissue oath or declaration because he or she believes the change in inventorship (to be effected) is not correct, the reissue application can still be filed with a petition under 37 C.F.R. 1.47 without that inventor's signature **>provided the written consent of all owners/assignees as required by 37 C.F.R. 1.172(a) is also submitted. In the situation where a patent to inventors X and Y has no assignee and a reissue application is filed by inventor Y to delete the name of inventor X as an inventor and to broaden the patent. Inventor X refuses to sign the reissue oath or declaration and refuses to provide the consent as required by 37 C.F.R. 1.172(a). In this instance, a 37 C.F.R. 1.47 petition would not be appropriate to permit the filing of the reissue application since the consent requirement of 37 C.F.R. 1.172(a) for each owner/assignee is not met. Resort to the courts would be required to delete the name of inventor X as an inventor where X will not consent to the filing of a reissue application. As stated in the second paragraph of 35 U.S.C. 256, "[t]he court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly."

A statement under 37 C.F.R. § 3.73(b) was filed on September 12, 2006, and the written consent to the reissue by the purported Assignee (Casa Herrera) was received on December 14, 2007.

However, neither of these documents can be accepted. The statement under 37 C.F.R. § 3.73(b) indicates that two assignments have been recorded in the Office: a first assignment from the inventors to an entity by the name of Machine Masters, Inc., and a second assignment from Machine Masters, Inc. to Casa Herrera (the purported assignee). The second assignment has been recorded, however Office records do not confirm that the first assignment was recorded at Reel 7069, Frame 0592 (as alleged on the statement under 37 C.F.R. § 3.73(b)). Moreover, this

statement indicates that a copy of this assignment documents was included with the statement under 37 C.F.R. § 3.73(b), however a copy of this assignment document has not been located in the electronic file.

The chain of title from the inventors to Casa Herrera has not been established. **On renewed petition, Petitioner will need to provide a copy of the assignment document where the inventors assigned their rights to Machine Masters, Inc. Moreover, this assignment document will need to be recorded and a new statement under 37 C.F.R. § 3.73(b), which properly identifies the recordation of this assignment document, will be required.**

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition pursuant to 37 C.F.R. § 1.47(a)." This is not a final agency action within the meaning of 5 U.S.C § 704.

Any such renewed petition should indicate in a prominent manner that the attorney handling this matter is Senior Attorney Paul Shanowski, and may be submitted by mail,² hand-delivery,³ or facsimile transmission (FAX).⁴ Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.⁵

Telephone inquiries regarding *this decision* should be directed to Senior Attorney Paul Shanowski at (571) 272-3225.⁶ All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

/KENNETH M. SCHOR/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

2 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

3 Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

4 (571) 273-8300 - please note that this is a central facsimile number.

5 <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

6 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).